

REMARKS

Applicants have reviewed the Final Office Action mailed March 3, 2006. Claims 1-6, 8, 17, 18, 20-26, 30, 31, 33-36, 39 and 45 are pending in the application, wherein claims 1-6, 8, 20, 33-36 and 39 have been withdrawn from consideration. Claims 7, 9-16, 19, 27-29, 32, 37, 38 and 40-44 have been previously cancelled.

As an initial matter, Applicants note that two claims were mistakenly withdrawn in the previous Response. An election was made to prosecute Species V, which corresponds to Figure 11. Applicants asserted that this species corresponded to claims 17, 18, 21-26 and 45. However, dependent claims 30 and 31 also read on this figure. Applicants respectfully request that these claims be considered in the next substantive examination.

Turning to the Office Action, the drawings were objected to. Apparently, the Examiner is making an assertion that all elements of the claims are not shown in the drawings. Applicants note that an election was made in a previous restriction requirement that corresponds to Figure 11. In describing Figure 11, the current application states that "actuator assembly 640 may comprise gear 660 coupled to button 642 that is axially rotatable." See page 12, lines 12-14 of the current application. Elements 640, 642 and 660 are all clearly numbered on Figure 11. Applicants respectfully assert that the "axially rotatable button coupled to a gear" is clearly shown in Figure 11 and discussed in the accompanying text, and thus no amendment of the drawings are necessary.

Claims 17, 18, 21-26 and 45 were rejected under 35 U.S.C. §103(a) as being unpatentable over Turovskiy et al., U.S. Publication No. 2002/0128679 (hereinafter "Turovskiy") in view of Gillick et al., U.S. Patent No. 6,755,854 (hereinafter "Gillick"), and further in view of Sugarbaker et al., U.S. Patent No. 5,928,264 (hereinafter "Sugarbaker"). Applicants respectfully traverse this rejection. In order for a combination of references to render a claim obvious, there must be some motivation or suggestion in the prior art to combine the references and each and every element of the claim must be present in the combination of references. See M.P.E.P. §2143.01 and §2143.03.

In the Office Action, the primary reference of Turovskiy is apparently being modified with a control device and mechanism of Gillick, and the control device and mechanism of Gillick in turn is being modified by adding a drive gear 82 of Sugarbaker.

Applicants assert that one of ordinary skill in the art would not be motivated to modify the cited references in this manner. Nothing in any of the cited references suggests the desirability of making the proposed modification of the control device and mechanism of Gillick with the driving gear 82 of Sugarbaker. It is apparently being proposed in the Office Action that the control device and mechanism of Gillick be modified by placing the driving gear 82 of Sugarbaker in place of the control knob (for example, control knob 32 as shown in Figure 1) of Gillick. Applicants respectfully assert that Gillick clearly teaches away from such a modification, and, because of this teaching away, one of ordinary skill in the art would not be motivated to combine these references as proposed in the Office Action.

It appears as though all of the embodiments shown and described in Gillick have an “actuating motion that can be substantially perpendicular to the line of motion of the proximal end of the restraining sheath.” For example see column 3, lines 37-38 and all of the figures. “As a result, the physician's manipulation of the control device, when retracting the restraining sheath, should not place a displacing force on the inner portion of the catheter which could otherwise cause the stent or graft to move from the target area.” Further, “the control mechanism also allows the physician to deploy a longer stent or graft with a shorter actuating motion to reduce the amount of manual actuation performed by the physician when retracting the restraining sheath. As a result, the physician only needs to push a thumb knob or trigger a short distance to cause the restraining sheath to retract a larger distance to fully expose the medical device for implantation.” The driving gear 82 of Sugarbaker would require a substantially different motion for actuation and, in addition, would appear to require multiple turns rather than a single push of a thumb knob or trigger. In contrast, Gillick repeatedly stresses that Gillick is teaching a specific type of actuating mechanism that has a motion that is substantially perpendicular to the object that is being manipulated, and also can deploy a longer structure such as a stent in one push of a button. As such, Gillick teaches away from modifying the actuating mechanism of Gillick with the driving gear 82 of

Sugarbaker. Because there is no motivation to combine these references, the combination of Turovskiy, Gillick and Sugarbaker cannot be used to render the pending claims obvious, and all pending claims are thus allowable.

Further, even if there were a motivation or suggestion to combine these references, this combination would not yield each and every element of the claims.

Claims 17 and 30 recite, among other elements, an axially rotatable button. Also, claim 45 recites, among other elements, the step of axially rotating a button. The driving gear 82 of Sugarbaker is not axially rotatable and it cannot therefore be an axially rotatable button. Nor do Turovskiy or Gillick disclose such a button. Thus, all elements of claims 17, 30 and 45 are not present in the cited prior art and these claims are allowable over the cited prior art. Because they are dependent on claims 17 and 30 and because they contain additional patentably distinct elements, Applicants assert that claims 18 and 31 are also patentable over the cited prior art.

Further, claim 17 recites, in part, an actuator assembly coupled to a proximal end of the outer sheath. Claims 21 and 45 recite, in part, an actuator coupled to the proximal tubular member. Turovskiy states that the “elongate member 11 is insertable in the lumen of introducer 15 and is connected to filter delivery cartridge 14 at its proximal end.” See paragraph 59. Turovskiy does not apparently disclose that anything that can be called an actuator or actuator assembly is attached to a proximal end of an outer sheath, as required by claim 17, or to a proximal tubular member, as required by claims 21 and 45. In addition, it does not appear that either Gillick or Sugarbaker disclose such a structure. Also, it does not appear that Turovskiy, Gillick or Sugarbaker disclose a proximal tubular member that includes teeth, as required by claims 21 and 45. Thus, the combination of Turovskiy, Gillick and Sugarbaker is missing at least the above elements of claims 17, 21 and 45, and Applicants assert that these claims are allowable over the cited references. Because they are dependent on claims 17 and 21 and because they contain additional patentably distinct elements, Applicants also assert that claims 18 and claims 22-26, 30 and 31 are also allowable.

Reexamination and reconsideration are respectfully requested. It is submitted that all pending claims are currently in condition for allowance. Issuance of a Notice of

Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at 612-677-9050.

Respectfully submitted,

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By their Attorney,

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